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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,236	02/13/2001	Robert J. Greenberg	S133-USA	1573

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EXAMINER

KHAN, OMAR A

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/783,236	GREENBERG ET AL.
	Examiner	Art Unit
	Omar A Khan	3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 October 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4, 11-16, 18-30, 34-36, 38-40, 48, 50 and 51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4, 11-16, 18-30, 34-36, 38-40, 48, 50 and 51 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) Interview Summary (PTO-413) Paper No(s). _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-4, 11-16, 18-30, 34-36, 38-40, 48, 50 and 51 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
(e) the invention was described in–
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1, 27, 28, 50 and 51 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hrdlicka (US Patent No 6,038,480).

3. Claims 1, 27, 28, 50 and 51 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Edell et al (US Patent No 5,476,494).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 18, 20, 26, 34, 35, 36, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow (US Patent No 5,024,223) in view of Hrdlicka. Chow discloses all of the claimed limitations, including a bent electrode array to better accommodate the curved shape of the eye, with the exception of a flexible electrode array body. Hrdlicka discloses a retinal electrode method and apparatus having a flexible electrode array body for better approximating the curvature of the retina and providing a denser and closer fit of the electrodes over the retina. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the retinal electrode array of Chow, to include a flexible electrode array body as taught by Hrdlicka for better approximating the curvature of the retina and providing a denser and closer fit of the electrodes over the retina.

5. Claims 1, 2, 18, 20, 26, 34, 35, 36, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow in view of Edell. Chow discloses all of the claimed limitations, including a bent electrode array to better accommodate the curved shape of the eye, with the exception of a flexible electrode array body. Edell discloses a retinal electrode method and apparatus having a flexible electrode array body for better approximating the curvature of the retina and providing a denser and closer fit of the electrodes over the retina. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

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retinal electrode array of Chow, to include a flexible electrode array body as taught by Edell for better approximating the curvature of the retina and providing a denser and closer fit of the electrodes over the retina.

6. Claims 3, 23, 25, 27, 28, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow (U.S. Patent No. 5,024,223) in view of Hrdlicka et al. (U.S. Patent No. 6,038,480). Chow clearly discloses all of the claimed limitations with the exception of an electrode array body having rounded edges and a radius of spherical curvature decreasing near its edges. Hrdlicka teaches a retinal electrode array assembly having rounded edges and a radius of curvature decreasing at the edges to reduce pressure and stress on the retina. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the retinal electrode assembly of Chow by rounding the edges and decreasing the radius of curvature to reduce stress and pressure concentrations on the retina. In the alternative, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the retinal electrode assembly of Chow to incorporate rounded edges and a decreased radius of curvature at the edges, since it was well known in the art that intraocular and retinal pressure are vital factors in retinal electrode design so that one of ordinary skill in the art would round the edges and decrease the radius of curvature to significantly reduce retinal pressure and stress concentrations.

7. Claims 3, 23, 25, 27, 28, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow (U.S. Patent No. 5,024,223) in view of Scribner (U.S. Patent No. 6,393,327). Chow clearly discloses all of the claimed limitations with the exception of an electrode array body having rounded edges and a radius of spherical curvature decreasing near its

edges. Scribner teaches a retinal electrode array assembly having rounded edges and a radius of curvature decreasing at the edges to reduce pressure and stress on the retina. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the retinal electrode assembly of Chow by rounding the edges and decreasing the radius of curvature to reduce stress and pressure concentrations on the retina. In the alternative, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the retinal electrode assembly of Chow to incorporate rounded edges and a decreased radius of curvature at the edges, since it was well known in the art that intraocular and retinal pressure are vital factors in retinal electrode design so that one of ordinary skill in the art would round the edges and decrease the radius of curvature to significantly reduce retinal pressure and stress concentrations.

8. Claims 4, 22, 24, 29, 30, 38, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow (U.S. Patent No. 5,024,223). Chow discloses all of the claimed limitations with the exception of the electrode array body being composed of silicone of a shore hardness of 50 or 25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the electrode array body of Chow to be made of silicone having a shore hardness of 50 or 25 since it was well known in the art that silicone of a shore hardness of 50 or 25 is a very common, soft, biocompatible material used in medical implantations and that intraocular and retinal pressures govern electrode array design so that one of ordinary skill in the art would make the electrode array body of silicone having a shore hardness of 50 or 25.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event; however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar A Khan whose telephone number is (703) 308-0959. The examiner can normally be reached on M-F 9AM-6PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0873.

OAK
12/27/02

Omar A Khan
December 27, 2002

GEORGE R. EVANISKO
PRIMARY EXAMINER

12/28/02